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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,596	11/14/2001	Mario P. Manfre	FDC 0164 PUS	9962
22045 7590 04/03/2007 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/992,596	<b>Applicant(s)</b> MANFRE ET AL.	
	<b>Examiner</b> Sara Chandler	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/12/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's election without traverse of claims 1-9 and 14-16 in the reply filed on 01/29/07 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 1 and 14: The terms "eligibility" and "eligible" in claims 1 and 14 render the claim indefinite. The terms are not defined by the claim and thus it is unclear which transactions are or are not subject to the claim limitations.

Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a) The claims reference a transaction decision regarding payment via the bank account. It is unclear from prior claim limitations what transaction decision is referred to? Also, how is the transaction processed and settled?

Dependent claims 2-9 and 15-16 are rejected based on the same rationale and claims 1 and 14.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-9 and 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson, US Pat. No. 5,053,607 in view of Nichols, US Pub. No. 2001/0037299.

**Re Claims 1-4:** Carlson discloses a method for processing a check transaction, the method comprising:

receiving transaction information that is transmitted by a terminal (Carlson, abstract, Figs. 1-7; col. 1, lin 1+ - col. 5, line 10; col. 6, line 38 – col. 9, line 46; col. 13, line 44+ - col. 16, line 18; col. 22, lines 34+ - col. 25, line 17)

The following term has been defined by the claims and has been given it's broadest reasonable interpretation: Terminal- any device through which data can be entered or displayed. See MPEP § 2111.;

Carlson fails to explicitly disclose:

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determining eligibility of the transaction for payment via a bank providing an electronic authorization response that is transmitted to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account; and

receiving an electronic response packet that is transmitted by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account.

Nichols discloses:

determining eligibility of the transaction for payment via a bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084]);

providing an electronic authorization response that is transmitted to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084])

Optional Language: The phrase “if” is optional language, and thus there is not a positive limitation recited. See MPEP § 2106 II C; See MPEP § 2111;

and

receiving an electronic response packet that is transmitted by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084])

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Optional Language: The phrase "if" is optional language, and thus there is not a positive limitation recited. See MPEP § 2106 II C; See MPEP § 2111.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Carlson by adopting the teachings of Nichols to provide a method further comprising: determining eligibility of the transaction for payment via a bank account; providing an electronic authorization response that is transmitted to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account; and receiving an electronic response packet that is transmitted by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account.

**Re Claim 5:** Carlson in view of Nichols discloses the claimed method supra and Nichols further discloses storing the authorization response in an authorization response file, storing the response packet in a response packet file, and comparing the response packet file with the authorization response file prior to settling the transaction (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

**Re Claim 6:** Carlson in view of Nichols discloses the claimed method supra and Nichols further discloses providing an electronic confirmation of receipt of the response packet that is transmitted to the terminal (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

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**Re Claim 7:** Carlson in view of Nichols discloses the claimed method supra and Nichols further discloses receiving a settlement request, and settling the transaction in response to the settlement request (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

**Re Claim 8:** Carlson in view of Nichols discloses the claimed method supra and Nichols further discloses wherein the step of receiving a settlement request occurs simultaneously with the step of receiving an electronic response packet (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

**Re Claim 9:** Carlson in view of Nichols discloses the claimed method supra and Nichols further discloses wherein the step of receiving a settlement request occurs after the step of receiving an electronic response packet (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

**Re Claim 14:** Carlson discloses a computer system for processing a check transaction initiated by a terminal.

The following term has been defined by the claims and has been given it's broadest reasonable interpretation: Terminal- any device through which data can be entered or displayed. See MPEP § 2111.

Carlson fails to explicitly disclose:

instructions for determining eligibility of the transaction for payment via a bank account;  
instructions for generating an electronic authorization response that is communicated to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account;

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and instructions for receiving an electronic response packet provided by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account.

Nichols discloses:

instructions for determining eligibility of the transaction for payment via a bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084]);

instructions for generating an electronic authorization response that is communicated to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084])

Optional Language: The phrase “if” is optional language, and thus there is not a positive limitation recited. See MPEP § 2106 II C; See MPEP § 2111.;

and instructions for receiving an electronic response packet provided by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account (Nichols, abstract; Figs. 1-7; [0001] – [0084])

Optional Language: The phrase “if” is optional language, and thus there is not a positive limitation recited. See MPEP § 2106 II C; See MPEP § 2111.

Intended Use: The claims make several intended use statements which do not carry patentable weight (i.e., “a system for”; “instructions for”). What follows the statement of intended use (i.e., “for”) does not carry patentable weight. The claimed



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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Carlson by adopting the teachings of Nichols to provide: instructions for determining eligibility of the transaction for payment via a bank account; instructions for generating an electronic authorization response that is communicated to the terminal, the authorization response including a unique transaction identifier if the transaction is eligible for payment via the bank account; and instructions for receiving an electronic response packet provided by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding payment via the bank account.

**Re Claim 15:** Carlson in view of Nichols discloses the claimed system supra and Nichols further discloses

instructions for storing the authorization response in an authorization response file (Nichols, abstract; Figs. 1-7; [0001] – [0084]),

instructions for storing the response packet in a response packet file (Nichols, abstract; Figs. 1-7; [0001] – [0084]), and

instructions for comparing the response packet file with the authorization response file prior to settling the transaction (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

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**Re Claim 16:** Carlson in view of Nichols discloses the claimed system supra and

Nichols further discloses

instructions for providing an electronic confirmation of receipt of the response packet to the terminal (Nichols, abstract; Figs. 1-7; [0001] – [0084]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Pub and US Pat. references deal with processing a check transaction.

2003/0088514- Sesek

20030069941- Peiffer

2003/0050892- Clynes

2003/0050889- Burke

2003/0033252- Buttridge

2002/0178112- Goeller

2002/0174074- Meadow

2002/0169720- Wilson

2002/0152169- Dutta

2002/0152166- Dutta

2002/0154164- Clapper

2002/0152170- Dutta

2002/0103756- Andrews

2002/0087463- Fitzgerald

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2002/0062286- Tedesco

7,181,430- Buchanan

6,856,965- Stinson

6,786,398- Stinson

6,757,664- Cardinal

6,728,397- McNeal

6,647,376- Farrar

6,282,523- Tedesco

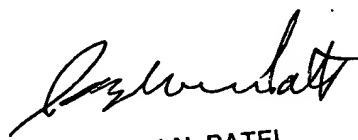
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



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